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XC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/373,984	08/16/99	SU	700027021-17

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HM12/0724

EXAMINER
TUNG, J

ART UNIT
1036

PAPER NUMBER

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DATE MAILED: 07/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Advisory Action

Application No.

09/373,984

Applicant(s)

Su et al.

Examiner

Joyce Tung

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 6/27/01 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Please see the attached.

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
please see the attached.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: claims 1, 3-13 and 20-25
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

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1. The newly added language “reaction vessel comprising a four enzyme mix” raises new issue that requires further consideration and/or search.

2. Regarding the provisional rejection of claims 5-8 and 10-22 under the judicially created doctrine of obvious-type double patenting over claims 1-17,24-43 and 50-69 of co-pending Application No.09/285,658, since the terminal disclaimer has not been submitted, the rejection is maintained.

3. Regarding the rejection of claims 1, 3-13 and 20-24 under 35 U.S.C. §112, second paragraph, the response argues that the term proportional amplification refers to the amplification of nucleic acid having the same or constant ratio. The response further argues that the method provides reproducible results sufficient to facilitate the measurement of quantitative as well as qualitative differences in nucleic acid expression in tested samples. However, the limitation from the specification is not read into the claim and it appears that if amplification method is properly performed, it always provides reproducible results sufficient to facilitate the measurement of quantitative as well as qualitative differences in nucleic acid expression in tested samples. It is unclear what is meant by “reproducible results”. The argument is not persuasive. Thus the rejection is maintained.

4. Claims 1, 3-13 and 20-25 are vague and indefinite under 35 U.S.C. 112, second paragraph because the language “said amplification is proportional” is unclear how the language is defined in the specification.

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5. Regarding the rejection of claims 1 and 3-12 under 35 U.S.C. §102(b) as being anticipated by Kwoh et al., the rejection is maintained because the language “proportional amplification” is unclear as set forth in section 3, above.

6. Claims 1 and 3-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kwoh et al. (Proc. Natl. Acad. Sci. USA, 1989, Vol. 86, pg. 1173-1177).

7. Regarding the rejection of claims 1, 13 and 20-24 under U.S.C. §103(a) over Kwoh et al. in view of Goller et al., Compton and Schnipelsky et al. because the language “proportional amplification” is unclear as set forth in section 3, above.

8. Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwoh et al. (Proc. Natl. Acad. Sci. USA, 1989, Vol. 86, pg. 1173-1177) in view of Goller et al. (Oncogene, 1998, Vol. 16, pg. 2945-2948).

9. Claims 1 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwoh et al. (Proc. Natl. Acad. Sci. USA, 1989, Vol. 86, pg. 1173-1177) in view of Compton (Nature, 1991, Vol. 350(7), pg. 91-92).

10. Claims 1 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwoh et al. (Proc. Natl. Acad. Sci. USA, 1989, Vol. 86, pg. 1173-1177) in view of Schnipelsky et al. (5,229,297).

11. Regarding the rejection of claim 25 under 35 U.S.C. 103(a) as being unpatentable over Kwoh et al. as applied to claim 1 and further in view of Sooknanan et al. because the language

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“proportional amplification” is unclear as set forth in section 3, above. Thus, the rejection is maintained.

12. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kwoh et al. (Proc. Natl. Acad. Sci. USA, 1989, Vol. 86, pg. 1173-1177) as applied to claim 1 in section 8 of the Office action mailed 10/5/2000, and further in view of Sooknanan et al. (WO 96/17079).

13. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached at (703) 308-1152.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

14 Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1656 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

July 17, 2001

Kenneth R. Horlick, Ph.D.
KENNETH R. HORLICK
PRIMARY EXAMINER
GROUP 1600 7/23/01